

**Remarks/Arguments**

The Examiner rejects claim 1-12. The applicant cancels claim 11 in this response. Claims 1-10 and 12 remain pending.

***Drawing Objections***

The drawings are objected to as failing to comply with 37 CFR 1.84(p) (5) because they are missing reference sign 105 of line 309 in the Detailed Description. The applicant has amended line 309 to change "105" to "165" (see Amendments to the Specification, above). Withdrawal of the objection is requested.

The drawings are objected to as failing to comply with 37 CFR 1.84(p) (5) because they include the following reference characters not mentioned in the description: 325, 330 of Fig. 3. The applicants have amended the specification to add "(blocks 325, 330)" at lines 249-250.

***Specification Objections***

In paragraph 4 of the Office Action, the Examiner objects to lines 35, 82, 128, 172, 309, 333 and 334-339 for grammar, reference numeral typos and clarity objections. The applicants have amended those lines of the disclosure as suggested by the Examiner to overcome their respective objections and such withdrawal is requested.

***Claim Objections***

Regarding claim 3, the Examiner objects to claim 3 because the word "to" is missing between "in response" and "empty data indication" at lines 9-10. The applicants have amended claim 3 to add "to" as suggested by the Examiner and requests withdrawal of the objection. Additionally, the applicants assert that the amendment to claim 3 was made to overcome a clerical mistake, was not an amendment

substantially related to patentability and was not made in view of cited or applied art.

Regarding claims 8-10, the Examiner objects to them because "predetermined" is misspelled in lines 1-2 of claim 8 and claim 9-10 inherit this deficiency of claim 8. The applicant has amended claim 8 to correct the misspelling and overcome the objection and requests withdrawal of the objection to claims 8-10.

Regarding claim 10, the Examiner objects to the same under 37 CFR 1.75 as being a substantial duplicate of claim 9. The applicants have cancelled claim 10 to overcome the objection.

Regarding claim 11, the Examiner objects to the same because "memory" in line 3 should be correct to "memories" and the phrase "first and second old memories" (lines 4-5) should be removed. The applicants have cancelled claim 11.

***Claim Rejections - 35 USC§ 102***

**35 U.S.C. §102(b) (Claims 1-5)**

Claims 1-5 are rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,664,114 ("the Krech patent"). The applicants respectfully traverse the rejections.

Regarding claim 1, the Examiner writes that the "first memory in communication with the processor" is anticipated by memory 111 of Fig. 1 on board 110 at column 43, line 11. The applicants have amended claim 1 to overcome the present rejection.

Regarding claim 2, claim 2 depends from amended claim 1 and so contains each of its limitations. The applicants respectfully request withdrawal of the rejection of claim 2 based on the amendment to claim 1. Additionally, the applicants respectfully assert that a RAM buffer is not "a hub" as understood by one of ordinary skill in the art and so the Kamei patent does not teach "a hub in communication with

the bus." (claim 2) The applicants respectfully request withdrawal of the rejection to claim 3 based on these points.

Regarding claim 3, claim 3 depends from amended claim 1 and so contains each of its limitations. The applicants respectfully request withdrawal of the rejection of claim 3 based on the amendment to claim 1.

Additionally, the applicants respectfully assert that the Kamei patent does not anticipate the controller **module**. (Claim 3) It is well-settled that each word in a claim must have meaning. Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 93 F.3d 1572, 1582 (Fed. Cir. 1996). The applicants assert that the Kamei reference does not teach a **modular** system and respectfully request withdrawal of the rejection of claim 3 based on these points. Assuming, *arguendo*, the word "module" is not well understood in the art, on July 12, 2005, in an *En Banc* decision, the Federal Circuit overturned the Texas Digital line of cases that condoned the adoption of a dictionary definition entirely divorced from the context of the written description. See Phillips v. AWH Corp. et al., 2005 U.S. App. LEXIS 13954, \*49 (Fed. Cir. 2005) (decided July 12, 2005). The Federal Circuit now "focuses at the outset on how the patentee used the claimed term in the claims, specification, and prosecution history, rather than starting with a broad definition and whittling it down" through the use of dictionaries in every case. Id. at \*50. By way of example and not limitation, the applicants illustrate the controller module and an application module in a modular relationship in Figures 1, 4-6 and at least pages 5 and 6 and 10-13. The Krech patent fails to teach use of any modular components as described and illustrated in the specification and so the applicants respectfully request withdrawal of the rejection of claim 3.

Regarding claims 4 and 5, these claims depend from claim 3, which itself depends from amended claim 1. For at least the

reasons stated above for claim 3, the applicants respectfully request withdrawal of the rejection of claims 4 and 5.

35 U.S.C. §102(b) (Claims 8-10)

The Examiner rejects claims 8-10 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,272,607 ("the Baentsch patent"). The applicants respectfully traverse the rejections.

Regarding claim 8, the Examiner writes that Baentsch et al. disclose a method of installing a new memory...into a system." (Office Action at Para. 17(Column 3, lines 61-67 - column 3, lines 1-2). While the applicants agree that the cited text describes data being replicated, the applicants use the terms "old" memory and "new" memory, not "first" and "second," to describe detachable and replaceable memories as described in the specification and as described by "being in a position or place for the first time." See The Merriam-Webster Dictionary by Merriam-Webster, Incorporated (1997). The memories taught in the Baentsch patent are "contained in a resource-constrained environment of a smartcard." (Col 5, lines 40-42). The applicants assert that the internal and fixed memories should not be characterized as old and new. The applicants request withdrawal of the rejection of claim 8 based on these assertions.

Regarding claims 9-10, these claims depend from claim 8 and so contain each of its limitations. For at least the reasons stated above for claim 8, the applicants request withdrawal of the rejection of claim 9-10.

35 U.S.C. §102(b) (Claims 11)

Claim 11 is rejected under 35 U.S.C. §102(b) as being anticipated by DeKongin et al (US 6,178,520). The applicants have cancelled claim 11.

***Claim Rejections - 35 USCS 102***

**35 U.S.C. §103 (Claims 6, 7)**

The Examiner rejects claims 6 and 7 under 35 U.S.C. §103(a) as being unpatentable over the Krech patent in view of McNutt et al. (US 5,659,705) ("the McNutt patent"). The applicants respectfully traverse the rejection.

The Examiner writes that claim 6 distinguishes over the teaching of the Krech patent by its various limitations. Claim 6 ultimately depends from claim 3 and so contains each of its limitations. For at least the reasons stated above for claim 3, the applicants assert that claim 3 is not anticipated by the Krech patent and so requests withdrawal of the rejection of claim 6.

Similarly, claim 7 depends from claim 4, which itself depends from claim 3. For at least the reasons stated above for claim 3, the applicants request withdrawal of the rejection of claim 7.

**35 U.S.C. §103 (Claim 12)**

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over DeKoning et al. (US 6,178,520) in view of the Krech patent. The applicants have rewritten claim 12 in independent form incorporating each of the limitations of the base claim. In response to the 103(a) rejection of claim 12, the applicants traverse the rejection.

The Examiner writes that the Krech patent discloses "said new memory transmitting an empty data indication to said processor if said new memory does not store any data (column 5, lines 10-12)." (Office Action at Para. 26) The applicants assert that the cited text in the Krech patent teaches a memory 112 (a FIFO memory) that is embedded in a graphics accelerator 100, not a "new" memory as used both in the claim's preamble, specification and in a dictionary sense. As suggested above, each word in a claim must have meaning



Application No. 10/649,906  
Amtdt. Dated December 7, 2005  
Reply to Office Action of September 19, 2005

Docket No. 100201032-1

(Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 93 F.3d 1572, 1582 (Fed. Cir. 1996)) and the preferred meaning is used in the claims, specification, and prosecution history, rather than starting with a broad definition and "whittling it down" through the use of dictionaries in every case. See Phillips v. AWH Corp. et al., 2005 U.S. App. LEXIS 13954, \*49 (Fed. Cir. 2005) (decided July 12, 2005). Based on the above assertions, the applicant respectfully requests withdrawal of the rejection of claim 12.

#### **Conclusion**

The applicant believes claims 1-10 and 12 are now in a condition for allowance. A Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,

Date: December 7, 2005

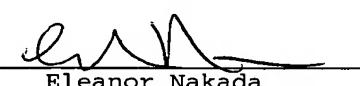
By: James K. Dawson  
James K. Dawson  
Registration No. 41,701  
Attorney for Applicants

Hewlett-Packard Company  
P.O. Box 272400  
Intellectual Property Administration  
Fort Collins, CO 80527-2400

#### **CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service, Express Mail Label EV460254635US, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

12-7-05  
Date

  
Eleanor Nakada